



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,282	09/21/2001	Brian Sagar	069918.00000	2554
35979	7590	12/06/2005		
BRACEWELL & GIULIANI LLP P.O. BOX 61389 HOUSTON, TX 77208-1389			EXAMINER COLE, ELIZABETH M	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 12/06/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/889,282

Applicant(s)

SAGAR, BRIAN

Examiner

Elizabeth M. Cole

Art Unit

1771

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57 and 59-118 is/are pending in the application.
- 4a) Of the above claim(s) 74-80 and 105-112 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 57, 59-73, 81-104, 113-118 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 1771

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/27/05 has been entered.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 57, 59, 61, 64-73, 113, 115 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 02-043275 in view of Rizika et al, U.S. Patent No. 5,650,213 for the reasons set forth in paragraph 1 of the previous action.

3. Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '275 in view of Rizika as applied to claims 57, 59, 61, 64-73, 116-118 above, and further in view of Yoshida et al, U.S. Patent No. 4,985,484 as set forth in paragraph 2 of the previous action.

4. Claims 63, 60, 81-104, 114, 116 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '275 in view of Rizika as applied to claims 57, 59, 61, 64-73, 116 above, and further in view of WO 95/14248 as set forth in paragraph 3 of the previous action.

Art Unit: 1771

5. Claims 117-188 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '275 in view of Rizika as applied to claims above, and further in view of JP 02300253. JP '275 does not teach employing a silane coupling agent. JP '253 teaches that silane coupling agents were art recognized equivalents to blocked isocyanate coupling agents in the art of forming ink compositions. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed a silane coupling agent as the coupling agent in the composition of JP '275, motivated by the teaching that silane coupling agents were known to be equivalents to the blocked isocyanate coupling agents disclosed in JP '275.

6. The Declaration under 37 CFR 1.132 filed 9/27/05 is insufficient to overcome the rejection of claims 57, 59-73, 81-104, 113-118 based upon JP '275 and Rizika as set forth in the last Office action because:

7. The Declaration states that the retroreflective ink compositions have enjoyed commercial success and sets forth the amount of sales generated in support of this contention. However, MPEP 716.03 requires that to show commercial success, a nexus must be shown between the claimed invention and the evidence provided, that the evidence must show that the commercial success is due to the claimed invention and not other factors such as pricing, advertising, etc., and that sales figures be shown in terms of market share. Therefore, the showing in the Declaration is not sufficient to overcome the prior art rejection because the Declaration does not meet the standards set forth in the MPEP. Also, it is noted that the Declaration refers to the ink composition having a long shelf life as the reason for the commercial success, but the claims only

Art Unit: 1771

recite the shelf life of the coupling agent, not the shelf life of the ink composition in general. Therefore, the showing is not commensurate in scope with the claims.

8. The Declaration also states that the other competing products were three pack ink which could only be used for about six hours after mixing as compared to the present invention which is a one pack ink with a shelf life of not less than 3 months. However, only claim 102 recites that the composition is a one pack ink with a particular shelf life. Also, it is noted the JP '275 employs a blocked isocyanate coupling agent and differs from the claimed invention mainly because it does not teach incorporating the glass microspheres into the ink composition.

9. The Declaration states that the retroreflective ink of Rizika would not have extended shelf life because the coupling agents are reactive at ambient temperatures. However, Rizika is only relied on for the teaching of incorporating the particular particles into ink compositions. The JP '275 reference is relied on for the teaching of the ink composition.

10. The Declaration argues that JP '275 does not relate to retroreflective inks since it does not comprise the retroreflective particles. However, Rizika teaches incorporating such particles into ink compositions. The Declaration states that one of ordinary skill in the art would not have looked to JP '275 when looking at the problem of making retroreflective inks more stable since the ink in JP '275 is solvent based. However, as set forth above, JP '275 is not relied on for the teaching of the retroreflective particles, since Rizika teaches incorporating these types of particles into ink compositions. Further, the instant claims are not specific as whether the ink is aqueous or solvent

Art Unit: 1771

based and JP '275 has the same components other than the retroreflective particles.

Also, JP '275 is disclosed as having a long shelf life. See abstract.

11. The Declaration states that the ink of JP '275 would not be suitable for use for screen printing onto textile substrates. However, the instant claims are drawn to an ink composition, not to a printed textile or to a method of printing. Therefore, this argument is not persuasive.

12. Applicant's arguments filed 9/27/05 have been fully considered but they are not persuasive. Applicant argues that the Declaration shows the commercial success of the product and comments on the long felt need of a one pack ink having a long shelf life. The same points set forth by the examiner in regard to the Declaration are also applicable to these arguments. Further, it is noted that the ink of JP '275 is disclosed as having a long shelf life and is a one pack ink. Applicant discusses the Declarations statements that JP '275 and Rizika would not have been considered by one of ordinary skill in the art who was seeking to make an ink with a longer shelf life. However, the ink of JP '275 is clearly taught to have a long shelf life. The only difference between JP '275 and the claimed invention is that JP '275 does not employ the retroreflective particles. However, Rizika teaches that such particles can be included in ink compositions in order to make them have a pleasing appearance. Therefore, it is the examiner's position that one of ordinary skill in this art would have looked to JP '275 because it relates to inks having a long shelf life and to Rizika because it teaches known additives which can be included in inks to provide a pleasing appearance to materials on which the ink is disposed. Applicant argues that the Declaration shows

Art Unit: 1771

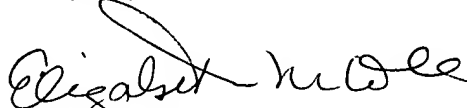
that one of ordinary skill would not have looked to JP '275 because the JP '275 ink cannot be used for screen printing. However, the instant claims are not drawn to a screen printed textile but to an ink composition.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (571) 273-8300.


Elizabeth M. Cole
Primary Examiner
Art Unit 1771

e.m.c